UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,129	12/12/2001	Yeong-Taeg Kim	SAM2.0004	2469

23386	7590	03/24/2006	

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CHANG, SHIRLEY

ART UNIT	PAPER NUMBER
2623	

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date *2/17/06, 9/7/04, 5/19/03*

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1.   Claim(s) 1-4, 6-8 is/are rejected under 35 U.S.C. 102(e) as being anticipated

by Zigmond (6698020).

As to claim 1, Zigmond discloses:

A method for operating a digital television receiver, which comprises: providing a digital

television receiver (fig. 3, el. 60; col. 7, lines 37-67) performing a Digital TV function

(displaying an advertisement col. 7, lines 25-36);

storing a plurality of advertisement messages in a storage device (fig. 5, el. 84; col. 15,

lines 17-34; fig. 4, el. 62, col. 8, lines 1-11);

subsequent to storing the plurality of the advertisement messages, using the digital

television receiver to receive video data from a digital television service provider (fig. 3,

el. 66; col. 8, lines 29-38; col. 7, lines 1-25);

with the digital television receiver, outputting the plurality of the advertisement

messages and the received video data (fig. 3, el. 58; col. 8, lines 29-38); and

if a predetermined number of the plurality of the advertisement messages has been output (el. 61 counts the number of times a viewer has seen a selected ad. Once the ad has been displayed the desired number of times, display of the advertisement to the viewer is blocked col. 13, lines 40-47), then disabling the digital TV function (display of the advertisement to the viewer is blocked col. 13, lines 40-47) of the digital television receiver.

As to claim 2, Zigmond discloses:

after the digital TV function has been disabled, storing a new set of the plurality of advertisement messages in the storage device (advertisements continue to be transmitted col. 8, lines 29-39, and new advertisements are stored after an advertisement has reached its desired number viewing times col. 13, lines 40-47); and

subsequently enabling the digital TV function of the digital television receiver (ads that have not reached the desired number viewing counts proceed to be displayed col. 8, lines 29-39).

As to claim 3, Zigmond discloses:

performing the step of storing the new set of the plurality of the advertisement messages in the storage device by downloading the new set of the plurality of the advertisement messages from a network (fig. 8, el. 64; col. 8, lines 29-37).

As to claim 4, Zigmond discloses:

setting the predetermined number such that all of the plurality of the advertisement

messages that were stored will be output (advertisers pay for a guaranteed number of

exposures col. 14, lines 49-58).

As to claim 6, Zigmond discloses:

providing the storage device as a component of the digital television receiver (fig. 5, el.

84; col. 15, lines 17-34; fig. 4, el. 62, col. 8, lines 1-11).

As to claim 7, Zigmond discloses:

performing the step of storing the plurality of the advertisement messages by

downloading the plurality of the advertisement messages from a network (fig. 5, el. 84;

col. 15, lines 17-34; fig. 4, el. 62, col. 8, lines 1-11).

As to claim 8, Zigmond discloses:

receiving additional video data from the digital television service provider; with the digital

television receiver, outputting the additional video data without outputting the plurality of

the advertisement messages (col. 18, line 38 to col. 19, line 9); and limiting a duration

that the step of outputting the additional video without outputting the plurality of the

advertisement messages can be performed (information relating to program description

that appear in the feed. Since programs change, topics change and appear for a

duration; col. 18, line 38 to col. 19, line 9).

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed

or described as set forth in section 102 of this title, if the differences between the

subject matter sought to be patented and the prior art are such that the subject matter

as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall

not be negatived by the manner in which the invention was made.

2.   **Claim(s) 5, 12-13, 15 is/are rejected under 35 U.S.C. § 103(a) as being**

unpatentable over Zigmond (6698020) in view of Kim (20020010927).

As to claim 5,

Zigmond teaches out putting the plurality of advertisement messages that were stored

to be output (col. 15, lines 17-34; col. 18, lines 29-63).

Zigmond fails to specifically teach a banner and performing the outputting step such that

the plurality of advertisement messages that were stored are output as banner as

advertisement messages together with the received video data.

In an analogous art, Kim discloses a system of displaying the program signal with the

banner [0076].

It would have been obvious to one of ordinary skill in the art to modify Zigmond's system

to teach performing the outputting step such that the plurality of the advertisement

messages that were stored are output as banner advertisement messages together with

the received video data, as taught by Kim, so as to not frustrate users who wish to view

their chosen program from beginning to end without interruption.

As to claim 12,

Zigmond discloses:

A digital television receiver, comprising: a video decoder for decoding received video bit

streams of a selected program to obtain decoded video bit streams of the selected

program (col. 6, lines 40-47);

An ad storage device (fig. 5, el. 86) for storing data representing advertisement messages and thereby obtaining stored data (fig. 5, el. 84; col. 15, lines 17-34; fig. 4, el. 62, col. 8, lines 1-11);

An ad rendering unit for decoding and rendering the stored data to obtain rendered data (fig. 5, el. 84, 86, 83; [15, 16-34]; [12, 33-43]);

An ad manager unit for reading out the stored data from said banner storage device and for providing the stored data to said banner rendering unit, said banner manager unit generating a disable signal when a predetermined number of the advertisement messages, represented by the stored data, have been read out from the banner storage device (el. 61 counts the number of times a viewer has seen a selected ad. Once the ad has been displayed the desired number of times, display of the advertisement to the viewer is blocked col. 13, lines 40-47; display of the advertisement to the viewer is blocked col. 13, lines 40-47); and

Zigmond fails to specifically teach processing banner and a video reconstruction unit for combining the rendered data with the decoded video bit streams of the selected program to obtain a combined video output signal that includes information representing the selected program.

In an analogous art, Kim discloses processing a banner ([0076]) and a system of a video reconstruction unit for combining the rendered data with the decoded video bit

streams of the selected program to obtain a combined video output signal that includes

information representing the selected program (fig. 8,el. 807; [0076]).

It would have been obvious to one of ordinary skill in the art to modify Zigmond's system

to include processing banner and a video reconstruction unit for combining the rendered

data with the decoded video bit streams of the selected program to obtain a combined

video output signal that includes information representing the selected program, as

taught by Kim, so as to not frustrate users who wish to view their chosen program from

beginning to end without interruption.

Kim discloses: an output terminal connected to said video reconstruction unit for

receiving the combined video output signal and for outputting the combined video output

signal ([0076]).

As to claim 13,

Zigmond discloses:

a system control unit for receiving the disable signal and, in response thereto, for

prohibiting said output terminal from receiving the information representing the selected

program (el. 61 counts the number of times a viewer has seen a selected ad. Once the

ad has been displayed the desired number of times, display of the advertisement to the

viewer is blocked col. 13, lines 40-47; display of the advertisement to the viewer is

blocked col. 13, lines 40-47).

As to claim 15,

a network adapter (inherently inside the STB) for downloading the stored data into said

banner storage device from an external network (fig. 7, el. 64; col. 8, lines 29-37; fig. 5,

el. 84; col. 15, lines 17-34; fig. 4, el. 62, col. 8, lines 1-11).

**3.   Claim(s) 9-11 is/are rejected under 35 U.S.C. § 103(a) as being unpatentable
over Zigmond (6698020) in view of Gupta (20040073947), and in further view of
Dimitrova (6469749).**

As to claims 9 and 10,

Zigmond fails to specifically teach performing the limiting step by: initializing a counter to

a predetermined value; incrementing the counter by an amount corresponding to an

amount of time that the step of outputting the plurality of the advertisement messages

and the received video data is being performed; decrementing the counter by an

amount corresponding to an amount of time that the step of outputting the additional

video without outputting the plurality of the advertisement messages is being performed;

and when the counter reaches the predetermined value, discontinuing the step of

outputting the additional video without outputting the plurality of the advertisement

messages.

In an analogous art, Gupta discloses a system of performing the limiting step by:

initializing a counter to a predetermined value (counter resets to zero [0074]);

incrementing the counter by an amount corresponding to an amount of time that the

step of outputting the plurality of the advertisement messages and the received video

data is being performed ([0074]; [0078]; [0085]);

It would have been obvious to one of ordinary skill in the art to modify Zigmond's system

to teach performing the limiting step by: initializing a counter to a predetermined value;

incrementing the counter by an amount corresponding to an amount of time that the

step of outputting the plurality of the advertisement messages and the received video

data is being performed, as taught by Gupta, so as to allow monitoring of media and

determine which information to output.

Zigmond in view of Kim and in further view of Gupta fail to specifically disclose:

decrementing the counter by an amount corresponding to an amount of time; and when

the counter reaches the predetermined value, discontinuing the step of outputting the

advertisement messages.

In an analogous art, Dimitrova discloses a system of decrementing the counter by an

amount corresponding to an amount of time; and when the counter reaches the

predetermined value, discontinuing outputting the advertisement messages (the

commercial is eventually "forgotten" by the system; col. 7, lines 8-19).

It would have been obvious to one of ordinary skill in the art to modify Zigmond in view

of Gupta system to teach decrementing the counter by an amount corresponding to an

amount of time; and when the counter reaches the predetermined value, discontinuing

outputting the advertisement messages, as taught by Dimitrova, so as to allow the

system to determine how long to allow the commercial to air.

As to claim 11,

Gupta discloses:

providing the counter as a component of the digital television receiver (fig. 2, el. 180;

[0074]).

4.   Claim(s) 14 is/are rejected under 35 U.S.C. § 103(a) as being unpatentable

over Zigmond (6698020) in view of Kim (20020010927), and in further view of

Gupta (20040073947), and in further view of Dimitrova (6469749).

As to claim 14,

Zigmond discloses: said video reconstruction unit is outputting the information

representing the selected program without the rendered data (col. 18, line 38 to col. 19,

line 9).

Kim discloses: the rendered data is combined with the decoded video bit streams of the

selected program in said video reconstruction unit ([0076])

said video reconstruction unit also configured to selectively output the information

representing the selected program without the rendered data (fig. 8,el. 807; [0076]).

Zigmond in view of Kim fails to teach a counter having a value that is incremented.

In an analogous art, Gupta discloses a system of a counter having a value that is

incremented ([0074]; [0078]; [0085]);

It would have been obvious to one of ordinary skill in the art to modify Zigmond in view

of Kim's system to a counter having a value that is incremented, as taught by Gupta, so

as to allow monitoring of media and determine which information to output.

Zigmond in view of Kim, in further view of Gupta's system fail to specifically disclose:
said value of said counter being decremented in proportion to an amount of time during
and when the value of said counter reaches a predetermined lower limit value, said
video reconstruction unit being prohibited from outputting the information.

In an analogous art, Dimitrova discloses a system said value of said counter being
decremented in proportion to an amount of time during and when the value of said
counter reaches a predetermined lower limit value, said video reconstruction unit being
prohibited from outputting the information (the commercial is eventually "forgotten" by
the system; col. 7, lines 8-19).

It would have been obvious to one of ordinary skill in the art to modify Zigmond in view
of Gupta system to teach decrementing the counter by an amount corresponding to an
amount of time; and when the counter reaches the predetermined value, discontinuing
outputting the advertisement messages, as taught by Dimitrova, so as to allow the
system to determine how long to allow the commercial to air.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shirley Chang whose telephone number is (571) 272-8546. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SC

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